Attorney Docket No. <u>1029150-000116</u>

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|---|---|
| In re Patent Application of ) | **MAIL STOP / AFTER FINAL** |
| ) | |
| Bertus Karel Edens ) | Group Art Unit: 3653 |
| ) | |
| Application No.: 10/032,104 ) | Examiner: Jeffrey A Shapiro |
| ) | |
| Filing Date: December 31, 2001 ) | Confirmation No.: 6139 |
| ) | |
| Title: PRODUCTION OF MAIL PIECES AND ) | |
| PREPARATIONS THEREFOR ) | |
| ) | |
| ) | |

## AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

☒ A Petition for Extension of Time is enclosed.

☐ _____ Terminal Disclaimer(s) and the ☐ $ 65 ☐ $ 130 fee per Disclaimer due under 37 C.F.R. § 1.20(d) are enclosed.

☒ Also enclosed is/are: <u>NOTICE OF APPEAL</u>

☐ Small entity status is hereby claimed.

☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ $ 395 ☐ $ 790 fee due under 37 C.F.R. § 1.17(e).

☐ Applicant(s) requests that any previously unentered after final amendments <u>not</u> be entered. Continued examination is requested based on the enclosed documents identified above.

☐ Applicant(s) previously submitted _____ on _____ for which continued examination is requested.

☐ Applicant(s) requests suspension of action by the Office until at least _____ , which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

## Buchanan Ingersoll ⚖ Rooney PC
Attorneys & Government Relations Professionals

☒ No additional claim fee is required.

☐ An additional claim fee is required, and is calculated as shown below:

| AMENDED CLAIMS | | | | | |
|---|---|---|---|---|---|
| | No. of Claims | Highest No. of Claims Previously Paid For | Extra Claims | Rate | Additional Fee |
| Total Claims | 22 | 20 | 0 | x $ 50 (1202) | $ 0 |
| Independent Claims | 2 | 3 | 0 | x $ 200 (1201) | 0 |
| ☐ If Amendment adds multiple dependent claims, add $ 360 (1203) | | | | | $ 0 |
| **Total Claim Amendment Fee** | | | | | $ 0 |
| ☐ Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee | | | | | 0 |
| **TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT** | | | | | $ 0 |

☐ Charge _____ to Deposit Account No. 02-4800 for the fee due.

☐ A check in the amount of _____ is enclosed for the fee due.

☐ Charge_____ to credit card for the fee due. Form PTO-2038 is attached.

☒ The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date  September 11, 2006        By: _____

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703 836 6620

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of       )  **MAIL STOP / AF**

                                )

Bertus Karel Edens            )  Group Art Unit:  3653

                                )

Application No.: 10/032,104     )  Examiner:  Jeffrey A Shapiro

                                )

Filed: December 31, 2001      )  Confirmation No.: 6139

                                )

For:   PRODUCTION OF MAIL PIECES  )

       AND PREPARATIONS THEREFOR )

                                )

                                )

## REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated March 9, 2006, reconsideration of the subject patent application is requested.

The rejection of the claims as obvious over Hart Jr. et al. in view of Schneiderhan is respectfully traversed. It is asserted that it would have been obvious to one of ordinary skill in the art to stop Hart's setup program setup to wait for an operator response, as allegedly taught by Schneiderhan, for providing a mail production process with the flexibility of a semi-automated setup.

However, a combination of Hart Jr. et al. with Schneiderhan would not lead to a computer program or an apparatus as defined by claim 22 or, respectively, claim 29 of the present application.

Hart Jr. et al. describes a system for preparing mail pieces. The mail pieces each include a control document including data for determining a unique identification code. The unique identification codes refer to unique identification codes of mail piece records in a mailing control file and the mailing control file may

also comprise data determining specified job parameters for initial set-up of the

apparatus (column 2, line 59 – column 3, line 3 and column 4, lines 5-12). The

apparatus further comprises a controller to generate initial set-up signals to control

set-up of the inserter system in accordance with the specified job parameters

(column 3, lines 11-13).

> "At 120 controller 52A tests to determine if inserter system 10A is ready and
> has responded to the control signals; that is documents, inserts, envelopes,
> etc. have been loaded, needed stations of inserter systems 10A have been
> activated, and all necessary preparatory actions have been taken, as will be
> well understood by those skilled in the art. If system 10A is not ready then at
> 122 controller 52A loops back through 120 to wait for a ready condition."
> (column 5, lines 41-48)

Accordingly, Hart Jr. et al. only discloses that the apparatus determines

whether it is ready to carry out a job, but does not determine a manual change that

needs to be made to change the current physical property into the required physical

property, or to cause an indication representing such manual change to be

represented in humanly perceptible form prior to initiation of the production (features

C and D of each of pending claims 22 and 29).

Schneiderhan describes a matching system for ensuring that personalized

inserts are inserted in the proper envelopes, which may be personalized as well.

Fig. 14a and Fig. 15 merely suggest to wait for an operator response after data are

displayed on a CFT (steps 504 and 524). From column 15, line 7 to column 18,

line 41, it is described how a menu guides the operator through system set-up and

initialization. At various occasions, the menu prompts the operator to enter a

response. All responses have to be entered via the CFT/keyboard terminal 70 and do not involve any manual change of any physical property of the operating condition of the apparatus. Thus, Schneiderhan adds little to Hart Jr. et al., which already teaches to wait for an operator response when the apparatus is not ready to carry out a job.

Under the law, there must be some suggestion, teaching or motivation that would lead the ordinary artisan to combine the references in the manner proposed in the Official action. As is apparent, there is no suggestion or teaching from Schneiderhan of providing an indication of a manually-needed manual change prior to initiation of production, as presently claimed. Moreover, even though Schneiderhan discloses the need for insert stacks 26 or 28 to be provided (which presumably are intended to be physically provided by an operator), there is no teaching or suggestion in Schneiderhan of providing an indication that a stack needs to be provided. In other words, even though a physical property (i.e., the provision of a stack) seems to be required in Schneiderhan prior to commencing production, there is no disclosure of providing a representation relating to the need for such physical property. The only representations disclosed by Schneiderhan as being provided prior to the initiation of production relate to properties that do not require physical change.

Accordingly, it is submitted that there is no obvious combination of

Hart Jr. et al. and Schneiderhan under 35 USC §103 that would render claims 22

or 29 unpatentable.

Respectfully submitted,
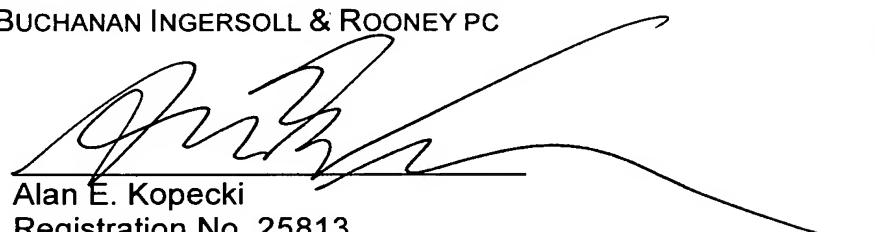
BUCHANAN INGERSOLL & ROONEY PC

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